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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,465	04/13/2001	George Harry Hoffman	41556/04005(RS11P101)	4781

22428 7590 05/05/2004

FOLEY AND LARDNER
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3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

ZEENDER, FLORIAN M

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,465

Applicant(s)

HOFFMAN ET AL.

Examiner

F. Ryan Zeender

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4, 6, 5, 8, 9</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 and all dependent claims recite limitations comprising only logic. Since "logic" does not comprise any physical element, the use of the terminology, "A system" appears to be misdescriptive.

Claim Rejections - 35 USC §101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-17, as best understood, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to

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promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-17 only recite an abstract idea. The recited steps/logic of merely determining an algorithm, establishing a contract, and selecting distributors/suppliers, do not necessarily apply, involve, use, or advance the technological arts since all of the recited steps/logic can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to govern an supply chain.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a manner to govern a supply chain which meets the "useful, concrete, and tangible" criteria.

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-17 are deemed to be directed to non-statutory subject matter.

Claims 13-17, as best understood, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims recite merely logic or computer code that is not embodied on a computer readable medium.

Claim Rejections - 35 USC § 103

Claims 1-20, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Duffy et al. in view of the PR Newswire article, "AGILE, ANDERSEN CONSULTING ANNOUNCE STRATEGIC ALLIANCE".

Duffy et al. disclose, or inherently teach: a supply chain governing framework utilizing a network including: determining an algorithm acceptable to distributors/suppliers (i.e., template and profile data; See for example paragraphs 0008, 0012, 0027, 0043, 0052, 0064); selecting the distributors/suppliers for operating in the supply chain utilizing the algorithm and supply chain data (See for example 0012, 0025, 0043, 0057); the framework provides buyers with a list of distributors/suppliers of interest as well as software for submitting purchase orders via template and the ability to track performance for confirmation of contract terms being met (See, at least, paragraphs 25-30, 35, 42, 45, 46, 60, 70, 85-93, 106); the algorithm including least cost data with the template (i.e., standardized/tiered) including product cost and capacities (see for example 0064); outputting information to a supply chain manager (i.e., the management system); the supply chain manager managing the suppliers and/or distributors based on the information received.

Duffy et al. lack the specific teaching of establishing a contract requiring a supply chain manager to manage distributors/suppliers utilizing the algorithm; the contract allowing the manager to deviate from the algorithm a predetermined amount; the least cost analysis including re-distribution cost; the manager collecting profit data; and the manager paying rebates.

The PR Newswire article teaches that it is well known for purchasing supply chain participants to contract with a supply chain manager (i.e., Andersen Consulting) to help with buying decision support, purchase orders, commodity and contract management, and supplier performance management (See, for example, the article page 2, paragraph 4) when utilizing an network-based supply chain management system (i.e., Agile's software).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Duffy et al. to contract with a supply chain manager resulting in the manager managing distributors/suppliers utilizing the algorithm; the contract allowing the manager to deviate from the algorithm a predetermined amount; the least cost analysis including re-distribution cost; the manager collecting profit data; and the manager paying rebates (i.e., "help with buying decision support and purchase orders"), in view of the PR Newswire article, in order to provide the buyer with a "proven methodology and experience in business transformation" and therefore "squeeze every possible penny" out of the buyer's operations (See page 3, paragraph 4 of the article).

Relevant Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The assignee, Restaurant Services Inc. (RSI), launched a product (RSI/Link) "to collect sales, shipment, pricing, and inventory information from Burger King's 350 suppliers and distributors" (See "A Whopping Inventory Task") in 1994.

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The article "Burger King Orders AT&T Mail Service" discusses how "the E-mail network will replace a manual, paper-based tracking and ordering system."

The Examiner requests that the applicant provide the Office with any known information relevant to the above mentioned product launch.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. Ryan Zeender whose telephone number is (703) 308-8351. The examiner can normally be reached on Monday-Friday, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bob Olszewski can be reached on (703) 308-5183. The receptionist's phone number for the Technology center is (703) 308-1113.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326 for before-final communications.

F. Zeender
Primary Examiner, A.U. 3627
April 30, 2004

 4/30/04